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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,421	09/28/2001	Hiroshi Nakajima	04739.0073	1510
22852	7590	07/13/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ALI, MOHAMMAD	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,421

Applicant(s)

NAKAJIMA ET AL.

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RD

DETAILED ACTION

1. This communication is in response to the application filed on 09/28/01.

The application has been examined and claims 1-8 are pending in this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "support system" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 recite the limitation "support method" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1-7, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" m

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pray et al. ('Pray' hereinafter), USP 4,885,694 in view of Amor et al. ('Amor' hereinafter), "ICAtect-II: a framework for the integration of building design tools".

With respect to claim 1,

Pray teaches a design support system (see col. 6-13), comprising:

a device for managing a design file formed of a series of work procedure data, which is identified by ID and consists of at least one work procedure data portion, and figure element data to be generated on the basis of each work procedure data portion (see col. 1, lines 38-41 and col. 18, lines 31-35, Fig. 7, Pray);

a device for recording a work procedure data portion (see col. 18, lines 31-35, Fig. 2, Pray), which corresponds to figure element data to be referenced, as specific information linked with a standard design file by ID for identifying the work procedure data portion when reference from the standard design file to figure element data contained in another design file is determined (see col. 11, lines 7-12, Fig. 8, Pray);

a first retrieval device for retrieving a corresponding work procedure data portion within another design file with ID, which is recorded in the specific information, used as a key in order to retrieve the each corresponding work procedure data portion when

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reference in the standard design file is executed (see col. 11, lines 35-40 and lines 50-52, Fig. 4, Pray); and

a second retrieval device for comparing a work procedure data portion of specific information or figure element data with contents of another design file when a corresponding work procedure data portion (see col. 6, lines 5-9, Pray) is not retrieved by the first retrieval device and retrieving a corresponding work procedure data portion on the basis of the compared result (see col. 7, lines 14-20, Fig. 2, Pray).

Pray does not explicitly indicate claimed comparing a work procedure.

Amor discloses claimed comparing a work procedure (see page 283, right, 3rd para, Amor).

It would have been obvious to one ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because comparing and work procedure of the Amor's teaching would have allowed Pray's system in a range procedures to ensure that design is consistent as suggested by Amor at page 278, left, para. 1. Comparing a work procedure as taught by Amor improves accomplish the designer to design tasks by detecting the conflicts data (see page 278, right, para. 3)

Claims 7 and 8 have the same subject matter as of claim 1 except module and Pray teaches at 3, lines 31-32 and essentially rejected for the same reasons as discussed above.

As to claim 2,

Pray teaches wherein the specific information is figure data resulting from processing of figure element data targeted for reference (see col. 4, lines 26-30, Fig. 1, Pray).

As to claim 3,

Pray teaches wherein the specific information is an input pattern of work procedure data (see col. 11, lines 27-30 et seq., Pray).

As to claim 4,

Pray teaches the specific data includes figure data resulting from processing of figure element data targeted for reference, and an input pattern of work procedure pattern (see col. 3, lines 23-29, Pray); and

the second retrieval device retrieves work procedure data targeted for reference with figure data as specific information used as a key (see col. 11, lines 7-12, Pray), and if work procedure data is not retrieved, retrieves work procedure data targeted for reference with the input pattern of the work procedure data itself used as a key (see col. 11, lines 39-40, Pray).

As to claim 5,

Pray teaches the figure data includes a name determined for each of figure element data by a draftsman (see col. 11, lines 65-67, Pray); and

the second retrieval device retrieves figure element data targeted for reference with figure data as specific information used as a key by comparing names determined by the draftsman (see col. 7, lines 14-20, Fig. 2, Pray).

As to claim 6,

Pray teaches the figure data includes a name determined for each of figure element data by a draftsman (see col. 11, lines 65-67 and col. 13, lines 40-41, Pray); and

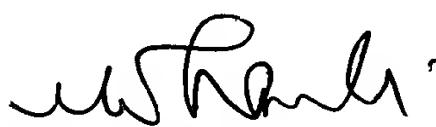
the second retrieval device retrieves figure element data targeted for reference with the figure data as specific information used as a key by comparing names determined by the draftsman (see col. 7, lines 14-20 and col. 13, lines 65-67, Fig. 2, Pray).

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mohammad Ali
Primary Examiner
Art Unit 2167

MA
July 11, 2005